

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 13, 16, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the use of the word “means” is unclear in identification means. Applicant can replace the word “means” with the word “file” or “indicia”. The word “means” is used in system claims, not in process claims (as in the present case). The word “file” or “indicia” is more clear than the word “means”. The language in “checking whether an identification means corresponding to said entity exists in said portable memory device, wherein a unique customer identifier of said identification means uniquely identifies said customer to said entity” is confusing. This language should be put in “if, then” language, such as “if said identification file does exist, wherein a unique customer identifier is present in said file, then”. The reason for putting this in “if, then” language is that if no such file exists, there is no point checking for a customer identifier.

In claim 13, the use of the word “and” is unclear. Examiner thinks applicant means one of a product “**or**” a service.

In claim 16, the use of the word nomination is unclear. Examiner thinks applicant means denomination. The examiner assumed that applicant meant denomination. Therefore, examiner searched prior art for monetary denomination.

In claim 23, the use of the word “and” is unclear. Examiner thinks applicant means one of a business entity “**or**” a government entity.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 and 17-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mankoff.

Concerning claim 1, Mankoff teaches a method for using a portable memory device by a customer to participate in an incentive program provided by an entity to the customer, the method comprising:

said customer temporarily providing said portable memory device to said entity;  
(Mankoff, col 2: 18-24, col 3: 34-38)

checking whether an identification means corresponding to said entity exists in said portable memory device, wherein a unique customer identifier of said identification means uniquely identifies said customer to said entity; (Mankoff, col 2: 15-18, col 1: 54-58, coupon provider is read as entity, abstract, claim 12)

if said identification means does not exist, said entity creating said identification means in said portable memory device and creating an account for said customer, corresponding to the incentive program, wherein said account is linked with said unique customer identifier; and (Mankoff, col 5, 34-40, claim 12, claim 13)

providing participation in said incentive program to said customer. (Mankoff, col 4: 39-55)

As to claim 2, Mankoff further discloses the step of said entity creating said account, without requesting any information related to said customer. (Mankoff, col 5, 37-40)

As to claim 3, Mankoff further discloses a unique customer identifier is used to anonymously identify said customer. (Mankoff, col 5: 37-42)

As to claim 4, Mankoff further discloses an identification means comprising at least one file in said portable memory device. (Mankoff, col 5, 34-40)

As to claim 5, Mankoff further discloses a file is used by said customer to anonymously identify with a web site associated with said entity by copying said file to a cookie folder on a computer used by said customer. (Mankoff, abstract, col 1: 44-58, Fig. 2, col 3: 40-49, claim 13)

As to claim 6, Mankoff further discloses anonymously identifying with said web site is used by said customer to receive online incentive provided by said web site. (Mankoff, col 1: 44-50, col 2: 3-6, col 2: 19-24, col 4: 14-17)

As to claim 7, Mankoff further discloses an online incentive is a discount provided by said web site towards online purchase conducted by said customer with said web site. (Mankoff, col 1: 67 – col 2: 2, col 5, 48-53)

As to claim 8, Mankoff further discloses the file having a unique file name corresponding to said entity. (Mankoff, col 3: 60, Fig. 3, element 50)

As to claim 9, Mankoff further discloses the file is digitally signed by said entity.  
(Mankoff, col 5: 29-40)

As to claim 10, Mankoff further discloses the participation in said incentive program comprising of said customer receiving membership benefits associated with said incentive program. (Mankoff, col 5: 21-25)

As to claim 11, Mankoff further discloses the participation in said incentive program further comprising of providing an instant discount towards a purchase by said customer.

(Mankoff, col 1: 64 – col 2: 2, abstract, Fig. 3, element 42)

As to claim 17, Mankoff further discloses the identification means further comprising:

said unique customer identifier; and (Mankoff, claim 12, claim 13, col 5: 37-40)

an association means to associate said unique customer identifier with said entity, wherein said entity receives said unique customer identifier from said portable memory device by using the association means. (Mankoff, claim 12, claim 13, col 5: 37-40, claim 1, col 1: 55-57)

As to claim 18, Mankoff further discloses the identification means further comprising at least one of a: identifier for said incentive program, name of said customer, address of said customer, telephone number of said customer, photo image of said customer, photo image of the signature of said customer, and a personal identification of said customer. (Mankoff, Fig. 3, element 44, col 3: 57-59, 63, other such useful information is read as “photo image of said customer, photo image of the signature of said customer, and a personal identification of said customer”)

As to claim 19, Mankoff further discloses the association means is the unique file name of the file written by said entity on said portable memory device, wherein one of the data component within said file comprising said unique user identifier and, said entity retrieves said unique customer identifier by reading said file. (Mankoff, col 5: 37-47)

As to claim 20, Mankoff further discloses the association means is a combination of a unique entity identifier and said unique customer identifier and writing this combination to a file on said portable memory device, wherein said entity retrieves said unique customer identifier from said portable memory device by searching for unique entity identifier in said file. (Mankoff, claim 9, claim 12, claim 13)

As to claim 21, Mankoff further discloses the portable memory device is a portable flash memory product. (Mankoff, col 3: 34-39)

As to claim 22, Mankoff further discloses the portable memory device is a portable memory card.  
(Mankoff, col 1: 10-17, col 3: 34-39, PCMCIA (Personal Computer Memory Card International Association) and handheld devices are read as portable memory card.

As to claim 23, Mankoff further discloses the entity is one of a business entity and a government entity. (Mankoff, col 1: 64, retail establishment is read as business entity)

**Claim 24** is rejected under 35 U.S.C. 102(b) as being anticipated by Biorge.

As per claim 24, Biorge teaches a system for providing an incentive program by an entity to a customer using a portable memory device, the system comprising: (Biorge, abstract)

a computer comprising a processor and means to receive portable memory device; (Biorge, col 4: 24-26, Fig 3, element 100, element 116, element 72, base device is read as computer, Summary of the Invention)

a removable portable memory device connected to said computer; and (Biorge, col 4: 21-24, Summary of the Invention)

said computer further comprising at least one computer readable medium comprising: (Biorge, col 9: 5 - 45, Fig 3)

the incentive program data base; (Biorge, col 2: 56-65, col 3: 7-21)

a first computer program comprising a set of instructions when executed by said processor causes the computer to perform the steps of: (Biorge, Fig 1, element 20)

checking whether the incentive program identification means exists in said portable memory device, wherein a unique customer identifier of said incentive program identification means uniquely identifies said customer to said entity;  
(Biorge, col 4: 61 – col 5: 15)

if said incentive program identification means does not exist, creating said incentive program identification means in said portable memory device and creating an incentive program account and linking said incentive program account with said unique customer identifier and storing in said incentive program data base; (Biorge, col 4: 2-6, col 3: 7-21)

if said incentive program identification means exists, reading said incentive program identification means and extracting data elements, wherein one of the data element is said unique customer identifier; and (Biorge, col 5: 3-4)

providing participation in said incentive program to said customer. (Biorge, col 5: 34-39)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff in view of Biorge.

Concerning claim 12, Mankoff discloses downloading electronic coupons to a PDA from a computer (abstract).

Mankoff does not specifically disclose checking for an awardable activity performed by customer or adding value to customer's account. Biorge discloses participation in said incentive program further comprising: checking for any awardable activity performed by said customer with said entity; and (Biorge, abstract) compensating said customer, wherein said compensation



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comprises of addition of value to said account. (Biorge, abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Mankoff to check for an awardable activity and add value as disclosed in Biorge because this would have increased the likelihood that customers would remain loyal and spend more money at that specific entity.

As to claim 13, Mankoff discloses downloading electronic coupons to a PDA from a computer (abstract).

Mankoff does not specifically disclose the awardable activity is said customer purchasing at least one of a product and a service from said entity. Biorge discloses the awardable activity is said customer purchasing at least one of a product and a service from said entity. (Biorge, abstract, col 1: 24-26, col 2: 50-53) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Mankoff to check if customer purchased products or services from entity as disclosed in Biorge because an entity would want to reward its loyal customers who spend more money at the entity's store.

As to claim 14, Mankoff discloses downloading electronic coupons to a PDA from a computer (abstract).

Mankoff does not specifically disclose the accumulated value in said account is redeemed for an award. Biorge discloses the accumulated value in said account is redeemed for an award. (Biorge, abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Mankoff to redeem the accumulated value

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for an award in Biorge because this marketing technique would help make customers more loyal and return to the same entity to buy future products.

As to claim 15, Mankoff discloses downloading electronic coupons to a PDA from a computer (abstract).

Mankoff does not specifically disclose the value is in the form of bonus points. Biorge discloses the value is in the form of bonus points. (Biorge, abstract, incentive credits are read as bonus points) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Mankoff to have the value in the form of bonus points in Biorge because increased consumer enthusiasm for games, incentives, and bonus points existed at that time.

As to claim 16, Mankoff discloses downloading electronic coupons to a PDA from a computer (abstract).

Mankoff does not specifically disclose the value is of a monetary denomination. Biorge discloses the value is of a monetary denomination. (Biorge, abstract, col 7: 21-25) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Mankoff to have the value in the form of a monetary denomination in Biorge because increased consumer enthusiasm for saving money existed at that time.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biorge in view of Rosenthal.

Concerning claim 25, Biorge teaches determining whether the provider card (portable memory device) is a valid device. If the card is invalid, the card is rejected. (Biorge, col 10: 49-51) Biorge does not specifically disclose checking whether the portable memory device contains harmful files, and aborting the processing if harmful files exist in the portable memory device. Rosenthal discloses the computer checking a floppy disk (portable memory device) for any harmful files, and to abort the processing if harmful files exist in the floppy disk (portable memory device). (Rosenthal, abstract, Fig. 7, element 108, col 1: 35, **col 13: 29-30**, floppy disks are read as portable memory device, col 13: 42-44, claim 1, claim 7, claim 15, claim 22, claim 30) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Biorge to check for harmful files as disclosed in Rosenthal because increased prevention of computer viruses existed at that time.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 6,467,686 B1 to Guthrie teaches a system and method for using a handheld device to use electronic coupons.

US Patent 5,970,469 to Scroggie teaches delivering incentives through a computer network, over the Internet or the World Wide Web.

US Patent 6,332,127 B1 to Bandera teaches establishing a link between a mobile web client and another computing device.

US Patent 5,905,246 to Fajkowski teaches a system for the electronic management and redemption of coupons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Berman whose telephone number is (571) 270-3603. The examiner can normally be reached on Monday through Friday 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Berman/

Examiner, Art Unit 4194

12/26/2007

/Charles R. Kyle/

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